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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/692,326 | 10/22/2003 | Dean Foote | LAMA121883 | 8551 |

26389 7590 04/01/2005

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EXAMINER

PATEL, VISHAL A

ART UNIT PAPER NUMBER

3676

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,326

Applicant(s)

FOOTE ET AL.

Examiner

Vishal Patel

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Le (US. 5,199,683).

Regarding claims 1-2: Le discloses a seal assembly (seal assembly of 10) for a reciprocating shaft (34) comprising a body (body 21) having a bore (bore where 34 is extended into), a shaft (34) adapted to move reciprocally within the body between an extended position extending from the body (figure 2 showing the shaft 34 in an extended position) and a retracted position retracted within the body (as seen in figure 1), at least one first circumferential seal (seal 70) positioned in the body and circumscribing the shaft and the shaft having first seal travel area (area of shaft that contacts 1, the first travel area extending from 32 and below 64) which is in contact with the first seal during axial reciprocating movement of the shaft (the first seal 70 will contact the first travel area during axial reciprocating movement of the shaft, seal 70 contacts the shaft both in non extended position as showed in figure 1 and in an extended position as showed in figure 2). At least a portion (portion of the first travel area) of the first seal travel area extending from the body where it is exposed to contaminants (contaminants in cavity 22) when the shaft is in the extended position (figure 2). The first circumferential seal being adapted to

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perform a sealing function of preventing fluids from migrating along the shaft from a first region of the body to a second region of the body (intended use) and the second circumferential seal being adapted to perform the same sealing function as the first circumferential seal and serve as a redundant backup seal until the first circumferential seal experiences seal failure (intended use).

At least one second circumferential seal (74) positioned in the body and circumscribing the shaft in axially spaced relation to the first circumferential seal, the shaft having a second seal travel area (second area of shaft extending above 54 and outside of 29) which is in contact with the second seal during axial reciprocating movement of the shaft (the second area is in contact with the seal) and the second seal area remaining sheltered within the body even when the shaft is in the extended position (this is the case since the first seal prevents contaminants from entering the space 66).

The first seal travel area and the second seal travel area being axially spaced separate and distinct areas on the shaft (the first and second areas are separate and distinct areas), such that damage to the exposed portion of the first seal travel area leading to a failure of the at least one first circumferential seal does not lead to failure of the at least one second circumferential seal (this is the case since contaminants do not exist on the second area of the shaft) and as the second circumferential seal engages the second seal travel area which separate and distinct from the first seal travel area (the second seal travel area is distinct from the first seal travel area).

The shaft is a ram shaft of a blow out preventer (34 is a ram shaft of blowout preventer, column 4, line 52).

Response to Arguments

3. Applicant's arguments filed 12/13/04 have been fully considered but they are not persuasive.

Applicants' argument is that the seal of Le is not capable of functioning as applicants seal is not persuasive because every claim limitation is disclosed by Le and as disclosed that fluid from 18 is prevented from going to the surface of 34a by the primary seal 70 which seal the shaft in a first area and seals 74 seal a second shaft area that is different from the first seal area and enclosed in the housing. Furthermore applicants argument to the use or functioning of Le is not persuasive since lee is capable of providing a primary seal and a back up seal.

4. In response to applicant's argument that the first circumferential seal being adapted to perform a sealing function of preventing fluids from migrating along the shaft from a first region of the body to a second region of the body (intended use) and the second circumferential seal being adapted to perform the same sealing function as the first circumferential seal and serve as a redundant backup seal until the first circumferential seal experiences seal failure (intended use), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thompson teaches a blowout preventer having a first and second seals contacting a first area and a second area of a shaft, respectively.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is (703) 308-8495. The examiner can normally be reached on Monday through Friday from 7:30 PM to 4:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (703) 308-2978.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168. Technology Center 3600 Customer Service is available at 703-308-1113. General Customer Service numbers are at 800-786-9199 or 703-308-9000. Fax Customer Service is available at 703-872-9325.

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to: 703-872-9326, for formal communications for entry before Final action: or,
703-872-9327, for formal communications for entry after Final action.

Hand-delivered responses should be brought to Crystal Park Five, 2451 Crystal Drive,
Arlington, Virginia, Seventh Floor (Receptionist suite adjacent to the elevator lobby).

VP

March 28, 2005



ALISON PICKARD
Primary Patent Examiner
Tech. Center 3600